REMARKS

This is a full and timely response to the outstanding Office action mailed June 23, 2005. Upon entry of the amendments in this response claims 1-74 are pending. More specifically, claims 1, 15-18, 35-38, 43, 52, and 63 are amended. These amendments are specifically described hereinafter.

I. Present Status of Patent Application

Claims 43 and 52 are objected to for alleged informalities. Claims 15-18 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 35-38 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-4, 19, 20, 22, 23, 24, 62, 63, 64, 65, 67-69, 72, and 74 are rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Rodriguez *et al.* (U. S. Patent Publication No. 2005/0071882). Claim 5 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Haddad (U.S. Patent No. 5,555,441) in view of Hooper *et al.* (U.S. Patent No. 5,414,455). Claim 6 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Haddad in view of Greenwood *et al.* (U.S. Patent No. 5,568,181). Claim 7-18, 21, 26-50 and 53-61 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Haddad in view of Hassell *et al.* (U.S. Patent Publication No. 2004/0128685) and further in view of Seazholtz *et al* (U.S. Patent No. 5,812,786). Claim 25 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Haddad in view of Hassell in view of Seazholtz, in view of Kitsukawa *et al.* (U.S. Patent Publication No. 2001/0013125). Claims 51 and 52 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Haddad in view of Hassell in view of Seazholtz, in view of Okamoto *et al.* (U.S. Patent No. 6,901,385). Claim 66 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Haddad in view of Wahl (U.S. Patent No. 5,898,456). Claim 70 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Haddad. Claim 71 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over

Haddad in view of Okamoto *et al.* Claim 73 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Haddad in view of Seazholtz. To the extent that these rejections have not been rendered moot by the cancellation of claims, they are respectfully traversed.

II. Rejections Under 35 U.S.C. §102(e)

Claims 1-4, 19, 20, 22-24, and 62

The Office Action rejects claims 1-4, 19, 20, 22-24, and 62 are rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by *Rodriguez* (U. S. Patent Publication No. 2005/0071882), and alternatively by *Haddad*. For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 1 as amended recites:

1. A recordable media content purchasing system comprising:
   a first memory; and
   a first processor configured with the first memory to download recordable media content at one of a plurality of various download times for purchase of the recordable media content, ***wherein the processor uses reallocated excess on-demand infrastructure capacity***.

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue. *See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q.2d 1129 (Fed. Cir. 1988).

The present Office Action tentatively rejects the aforementioned claims under 35 U.S.C. § 102(e) as allegedly unpatentable over U.S. Patent Application 10/981,053 (hereinafter the '053 application). Applicant submits a declaration from Arturo A. Rodriguez, pursuant to 37 C.F.R. § 1.132 corresponding to the following statement from the Office Action: "this rejection under 35 U.S.C. 102(e) might be overcome by ... a showing under 37 C.F.R. 1.132 that any invention

disclosed but not claimed in the reference was derived from the inventor of this application and is thus not invention "by another." See *Office Action*, sec. 4.

As noted in section 4 of the Office Action, the present application is assigned to the same assignee as the '053 application, and the co-inventor of the present application is a co-inventor of the '053 application. Arturo A. Rodriguez, the co-inventor of the presently claimed invention, also invented the material disclosed in the '331 patent that purportedly anticipates the present claims. Accordingly, and as invited by the Office Action (section 4), Arturo A. Rodriguez has executed an accompanying declaration made pursuant to 37 C.F.R. § 1.132, which avers this relevant fact. Accordingly, the rejection under 35 U.S.C. § 102(e) should be withdrawn, as the relevant subject matter of the '053 application does not constitute an invention "by another." As the claims were alternatively rejected in view of *Haddad,* the following remarks will address *Haddad* and not *Rodriguez.*

Applicant respectfully submits that independent claim 1 as amended is allowable for at least the reason that *Haddad* does not disclose, teach, or suggest at least **wherein the processor uses reallocated excess on-demand infrastructure capacity**. As detailed in the specification, one non-limiting embodiment "can effectively redirect allocation of excess VOD infrastructure capacity to facilitate maximum rate delivery of (PRM) content." See *Specification*, pg. 8, lines 31-32. This is not disclosed in *Haddad.* Therefore, *Haddad* does not anticipate independent claim 1, and the rejection should be withdrawn.

Because independent claim 1 as amended is allowable over the cited references of record, dependent claims 2-4, 19, 20, 22-24, and 62 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 2-4, 19, 20, 22-24, and 62 contain all the steps/features of independent claim 1. *See Minnesota Mining and Manufacturing Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002) *Jeneric/Pentron, Inc. v. Dillon Co.*, 205 F.3d 1377, 54 U.S.P.Q.2d 1086 (Fed. Cir. 2000); *Wahpeton Canvas Co. v. Frontier Inc.*, 870 F.2d 1546, 10 U.S.P.Q.2d 1201 (Fed. Cir. 1989). Therefore, since dependent claims 2-4, 19, 20, 22-24, and 62 are patentable over *Haddad*, the rejection to claims 2-4, 19, 20, 22-24, and 62 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 2-4, 19, 20, 22-24, and 62 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 2-4, 19, 20, 22-24, and 62 are allowable.

B. Claims 63-65, 67-69, and 72-74

The Office Action rejects claims 63-65, 67-69, and 72-74 are rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by *Rodriguez* (U. S. Patent Publication No. 2005/0071882) and alternatively by *Haddad*. For the reasons set forth below, Applicant respectfully traverses the rejection.

Independent claim 63 as amended recites:

63. A recordable media content purchasing method comprising the steps of:
receiving a user request for purchase of recordable media content; and
downloading the requested recordable media content at one of a plurality of various download times for purchase of the recordable media content, ***including during reallocated excess on-demand infrastructure capacity.***

For a proper rejection of a claim under 35 U.S.C. §102, the cited reference must disclose, teach, or suggest all elements/features/steps of the claim at issue.

The present Office Action tentatively rejects the aforementioned claims under 35 U.S.C. § 102(e) as allegedly unpatentable over U.S. Patent Application 10/981,053 (hereinafter the '053 application). Applicant submits a declaration from Arturo A. Rodriguez, pursuant to 37 C.F.R. § 1.132 corresponding to the following statement from the Office Action: "this rejection under 35 U.S.C. 102(e) might be overcome by ... a showing under 37 C.F.R. 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not invention "by another." See *Office Action*, sec. 4.

As noted in section 4 of the Office Action, the present application is assigned to the same assignee as the '053 application, and the co-inventor of the present application is a co-inventor of the '053 application. Arturo A. Rodriguez, the co-inventor of the presently claimed invention, also invented the material disclosed in the '331 patent that purportedly anticipates the present claims. Accordingly, and as invited by the Office Action (paragraph 4), Arturo A. Rodriguez has executed an accompanying declaration made pursuant to 37 C.F.R. § 1.132, which avers this relevant fact. Accordingly, the rejection under 35 U.S.C. § 102(e) should be withdrawn, as the relevant subject matter of the '053 application does not constitute an invention "by another." As the claims were alternatively rejected in view of *Haddad,* the following remarks will address *Haddad* and not *Rodriguez.*

Applicant respectfully submits that independent claim 63 as amended is allowable for at least the reason that *Haddad* does not disclose, teach, or suggest at least **downloading the requested recordable media ... including during reallocated excess on-demand infrastructure capacity**. As detailed in the specification, one non-limiting embodiment "can effectively redirect allocation of excess VOD infrastructure capacity to facilitate maximum rate delivery of (PRM) content." See *Specification*, pg. 8, lines 31-32. This is not disclosed in *Haddad.* Therefore, *Haddad* does not anticipate independent claim 63, and the rejection should be withdrawn.

Because independent claim 63 as amended is allowable over the cited references of record, dependent claims 63-65, 67-69, and 72-74 (which depend from independent claim 63) are allowable as a matter of law for at least the reason that dependent claims 63-65, 67-69, and 72-74 contain all the steps/features of independent claim 63. Therefore, since dependent claims 63-65, 67-69, and 72-74 are patentable over *Haddad*, the rejection to claims 63-65, 67-69, and 72-74 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 63, dependent claims 63-65, 67-69, and 72-74 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 63-65, 67-69, and 72-74 are allowable.

III. Rejections Under 35 U.S.C. §103(a)

A. Claims 5-18, 21, and 25-61

The Office Action rejects claim 5 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Haddad* (U.S. Patent No. 5,555,441) in view of *Hooper* (U.S. Patent No. 5,414,455). Claim 6-18, 21, 26-61 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Haddad* in view of Greenwood (U.S. Patent No. 5,568,181) further in view of *Hassell* (U.S. Patent Publication No. 2004/0128685) and further in view of *Seazholtz* (U.S. Patent No. 5,812,786). Claim 25 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Haddad* in view of *Hassell* and further in view of *Seazholtz* as applied to claim 7 above, and further in view of *Kitsukawa* (U.S. Patent Publication No. 2001/0013125

Because independent claim 1 is allowable over the cited art of record, dependent claims 5-18, 21, and 25-61 (which depend from independent claim 1) are allowable as a matter of law for at least the reason that dependent claims 5-18, 21, and 25-61 contain all the steps/features of independent claim 1. Therefore, the rejection to claims 5-18, 21, and 25-61 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 1, dependent claims 5-18, 21, and 25-61 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 5-18, 21, and 25-61 are allowable.

B. Claims 66 and 70

Claim 66 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Haddad* in view of *Wahl* (U.S. Patent No. 5,898,456). Claim 70 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Haddad.*

Because independent claim 63 is allowable over the cited art of record, dependent claims 66 and 70 (which depend from independent claim 63) are allowable as a matter of law for at least

the reason that dependent claims 66 and 70 contain all the steps/features of independent claim 63. Therefore, the rejection to claims 66 and 70 should be withdrawn and the claims allowed.

Additionally and notwithstanding the foregoing reasons for allowability of independent claim 63, dependent claims 66 and 70 recite further features and/or combinations of features, as are apparent by examination of the claims themselves, that are patently distinct from the cited art of record. Hence there are other reasons why dependent claims 66 and 70 are allowable.

IV. Miscellaneous Issues

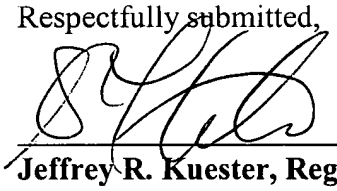
Claims 15-18 and 35-38 are amended to particularly point out and distinctly claim the subject matter. Claims 42 and 52 are amended to correct informalities. These amendments are not made for purposes of patentability.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-74 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned agent at (770) 933-9500.

Respectfully submitted,



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